

REMARKS

Claims 1-13, 15-24 and 26-36 are pending in the present application. Claims 1 and 24 have been amended. Claims 14 and 25 have been canceled without prejudice.

Amendment or cancellation of the originally filed claims should in no way be construed as an acquiescence, narrowing, or surrender of any subject matter. The amendments are being made not only to point out with particularity and to claim the present invention, but also to expedite prosecution of the present application. Applicants reserve the option to prosecute the originally filed claims further, or similar ones, in the instant or a subsequent patent application.

Election/Restriction

In response to the pending Restriction Requirement, Applicants confirm the provisional election, with traverse, Group I, claims 1-25. However, it is respectfully submitted that examination of all claims simultaneously would place no undue burden on the Examiner. For a restriction requirement to be valid, the Examiner must establish that the search and examination of the entire application cannot be made without serious burden (M.P.E.P § 803). Accordingly, Applicants respectfully request examination of all claims simultaneously.

Claim Rejections Based on 35 USC 102

Claim 1 stands rejected under 35 U.S.C § 102 (b) as being anticipated by Kong et al (Synthesis of individual single walled carbon nanotubes on patterned silicon wafers). The Examiner has indicated that the Applicant's invention has novelty over the prior art methods of attaching carbon nanotube tips. Solely to expedite prosecution, claim 1 has been amended to recite 'consisting of'. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim Rejections Based on 35 USC 103

Claims 1, and 20-25 stand rejected under 35 U.S.C § 103 (a) as being unpatentable over Colbert et al (WO 98/05920) taken with Kong et al. Solely to expedite prosecution, claim 1 has been amended to recite 'consisting of'. The Examiner asserts that Colbert et al teach that 'by bringing the tip next to the nanotube and performing a translation, the van der Waals forces

promote bonding between the nanotube and the tip.’ Claim 1 does not recite ‘performing a translation’. Claims 20-23 are dependent on claim 1. Claim 25 has been canceled. Claim 23 has been rewritten as an independent claim. The Examiner asserts that Colbert et al ‘disclose that an adhesive may be applied to the tip.

It is further taught that in the case of the adhesive requiring a cure, the appropriate conditions, such as UV light, heat etc. is provided’. Applicants assert that Colbert does not teach or suggest a method for fabricating a SWNT probe where the tip bearing SWNT is heated to 900 C. Applicants respectfully note that it is well-known in the art that a curing temperature for adhesives must be well below this temperature. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 2-13, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert et al and Kong et al and in further view of Smalley. Claims 15-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert et al and Kong et al and in further view of Smalley, and further in view of Ago et al. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Colbert et al and Kong et al. in further view of Dai et al. These claims dependent on claim 1 or dependent claims thereon, and for at least the reasons stated above, Applicants assert that claim 1 is now allowable. Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

Fees

The Applicants believe no fee is due in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any required fee to our Deposit Account, 06-1448.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-832-1000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this application be charged to Deposit Account, No. 06-1448.

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Respectfully Submitted,



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